

### **Remarks/Arguments**

The Request for Continued Examination (RCE) is provided in response to a final Office Action mailed July 28, 2005, in which claims 1-9, 13, and 15-29 were rejected under 35 U.S.C. §102(e) as being anticipated over prior art, and in which claims 10-12 and 14 were rejected under 35 U.S.C. §103(a) as being obvious in view of the prior art.

### **Claim Amendments**

The amendments to independent claims 1, 15-16, and 21 have not been made for reasons of patentability, but rather have been amended to more particularly point out and distinctly claim the subject matter regarded by the Applicants as their invention. The amendments to the claims have been made to make explicit that which was implicitly inherent and within the ordinary meaning of terms of art used within the language of claims, and as would be understood by one of ordinary skill in the art.

### **Rejection of Claims Under 35 U.S.C. §102(e)**

The Office Action rejected claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e) as being unpatentable over United States Patent No. 6,763,380 issued to Kim Irvin Mayton et al., July 13, 2004 (Mayton '380).

Anticipation means a lack of novelty, and is a question of fact which is reviewed by the reviewing court using a substantial evidence standard. *Brown v. 3M*, 60 USPQ2d 1375 (Fed. Cir. 2001); *Baxter Int'l, Inc. v. McGaw, Inc.*, 47 USPQ2d 1225 (Fed. Cir. 1998). To anticipate a claim, every limitation of the claim must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286 (Fed. Cir. 2001). *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002). Each such limitation must be found either expressly or inherently in the prior art reference. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 02-1540, Decided August 1, 2003 (Fed. Cir. 2003).

Mayton '380 fails to identically show either claim limitation of: "...the first and the second performance tests are performed simultaneously or **substantially simultaneously**" of claims 1 and 15-16. Mayton '380 further fails to identically show the claim limitation

of: "...a performance test is conducted between the first device and the second device over each of the first and second transport networks simultaneously or **substantially simultaneously**" of claim 21.

If the Applicant understands the Examiner's arguments correctly, the Examiner appears to have read the claim language of the Applicant's pre-amendment language of claims 1, 16, and 21 to read "within a close time proximity" as to mean within a close time proximity each day. For example, the first performance test is to run on day one at very nearly noon, and the second performance test is to run on day two and any subsequent days at very nearly noon. Mayton '380 seems to have been applied to overcome this reading of the claim language. The Examiner appears to read the Mayton '380 patent as disclosing network tests that are generally based on timing measurements and timing records performed periodically (Col.7: line 60 – Col.8 line 6). Moreover, this reading of Mayton '380 makes use of threshold criteria based on baseline measurements (Col.10 line 2-14; Col.12 line 66 – Col. 13 line 13; Col. 13 line 19-25). The Examiner's use of Mayton '380 further incorporates making use of, and updating, a historical data set when making comparisons (Col.10 line 21-30) and testing a performance test against an average time for the test (Col. 11 line 10-15; Col. 12 line 7-14; Col. 13 line 62-67). The Examiner appears to be arguing that that periodic tests are run at a uniform time period since the scheduled tests are executed within a close time period day to day and the results are compared with the baseline values to determine if any inconsistencies exist (Col. 14 line 19-34). Following this argument to conclusion, this would suggest that Mayton '380 runs a test over a path and calculates a correct time for the test and adds it to the historical log to make an average time. The next time that a test is run at approximately the same time of the day, or at some other scheduled time approximately at the same time of the day as the first test (normally on a subsequent day), the new test is run and compared to either the stored baseline test value, average test value, or historical test value.

The Applicant has therefore amended "within a close time proximity" to "substantially simultaneously" to clarify and more particularly point out and distinctly claim the subject matter regarded by the Applicants as their invention. The amendments to the claims have been made to make explicit that which was implicitly inherent by the term

“within a close time proximity”. Mayton ‘380 does not perform a first and second performance test simultaneously or substantially simultaneously, but rather performs tests on subsequent occasions at approximately the same time of the day and references the second test in light of the value determined from a first test that was not run simultaneously or substantially simultaneously as the second test. Therefore, Mayton ‘380 fails to provide a basis for an anticipation rejection under 35 U.S.C. § 102(e) of independent claims 1, 15-16, and 21.

Accordingly, the Applicants request withdrawal of the rejection of claims 1-9, 13, and 15-29 under 35 U.S.C. §102(e), and passage of same to allowance.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

The Office Action further rejected claims 10, 11, and 14 under 35 U.S.C. §103(a) as being unpatentable over Mayton ‘380 in view of United States Patent No. 6,360,268 issued to Stephen Silva et al., March 19, 2002 (Silva ‘268). This rejection is respectfully traversed.

The United States Court of Appeals for the Federal Circuit have provided specific guidance regarding the kind of factual findings needed to determine a reason, suggestion, or motivation to combine references in support of a prima facie showing of unpatentability under 35 U.S.C. §103(a). “The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 1572, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) (internal citations omitted); *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1458. While the references need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be “clear and particular.” *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.” *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (Fed. Cir. 2000)

As discussed above in the section titled “Rejection of Claims Under 35 U.S.C. §102(e)”, Mayton ’380 fails to teach or suggest the claim limitation of: “...the first and the second performance tests are performed simultaneously or **substantially simultaneously**” of claim 1. Mayton ’380 alone, or in combination, fails to teach or suggest this limitation. Moreover, Silva ’268 supplies neither the missing element nor a “clear and particular” showing for the combinability of the two references.

Accordingly, the Applicant requests withdrawal of the rejection of claims 10, 11, and 14 under 35 U.S.C. §103(a), and passage of same to allowance.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

The Office Action further rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Mayton ’380 in view of United States Publication No. 20030036865 published to ZhangQing Zhuo et al., February 20, 2003 (Zhuo ’865). This rejection is respectfully traversed.

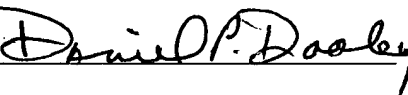
As discussed above in the section titled “Rejection of Claims Under 35 U.S.C. §102(e)”, Mayton ’380 fails to teach or suggest the claim limitation of: “...the first and the second performance tests are performed simultaneously or **substantially simultaneously**” of claim 1. Mayton ’380 alone, or in combination, fails to teach or suggest this limitation. Moreover, Zhuo ’865 supplies neither the missing element nor a “clear and particular” showing for the combinability of the two references.

**Conclusion**

The Applicants respectfully request reconsideration and allowance of all of the claims pending in the application. This RCE is intended to be a complete response to the final Office Action mailed July 28, 2005.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

By: 

Daniel P. Dooley  
USPTO Reg. No. 46,369  
R. Alan Weeks  
USPTO Reg. No.: 36,050  
321 South Boston Ave., Suite 800  
Tulsa, OK 74103-3318  
Telephone No.: (918) 599-0621  
Facsimile No.: (918) 583-9659  
Customer No.: 22206